

Amendments to the Drawings:

Formal drawings are submitted herewith under separate Letter to the Draftsperson. Approval by the Examiner is respectfully requested.

Attachment: Replacement Figures 1 and 2

REMARKS

The Examiner has stated that new corrected drawings are required in the instant application. In response thereto, Applicant has submitted concurrently herewith new formal drawings that are to be substituted for the drawings currently on file. Accordingly, Applicant respectfully submits that this objection is no longer applicable.

The Examiner, in the Official Action, rejected claims 1, 11, 21, 40 and 50 under 35 USC § 112 first paragraph. In particular the Examiner states that “said service provider providing feed back to said user based on said meta data and/or said user using said software with respect to said low resolution digital image file” is not supported as the disclosure does not support where both limitations are taken together. In this regard, Applicant respectfully submits that this is not true. In particular, Applicant refers the Examiner to page 6 of the specification lines 18 continuing on to the next page line 18. This portion of the specification is immediately following the transfer of the low resolution image file to the server (see page 6, lines 7-18). Thus, this portion is describing the time in which the low resolution image file has already been forwarded to the remote service provider 14. As can be seen, various goods or service products may be ordered during this time. As stated on page 7, lines 1-3, “the service provider may generate alternative suggestions of products and services and display a representation of these products and services using the low resolution image records.” Thus it is clear that initial feedback can be provided by the service provider based on the mere submission of the low resolution image file. In addition, in lines 4-6 on page 7, the meta data transfer allows the service provider to provide additional feedback to the user to perform automatic operations on the image records. Further, as stated therein, examples of feedback would be to provide warnings that the image data available is insufficient to produce at an expected quality level the requested product or service or that the image data available requires or would benefit from enhanced processing or steps. In referring to Figure 2, as can be seen by the flow diagram at step 34, there is the transmission of low resolution images, and then at step 38 the customer manipulates the digital image files as desired and then places the orders for goods and/or services. Thus, the feedback would inherently be based on the meta data

and/or the user using software at the service provider. Accordingly, Applicant respectfully submits there is adequate basis for this limitation.

The Examiner has also rejected claims 1, 11, 21, 40 and 50 under 35 USC § 112 second paragraph as being indefinite for failing to particularly point out and distinct claim the subject matter which applicant regards as the invention. In this regard, the Examiner objects to the term “said image” in line 6 of step b of claim 1. The Examiner states that this refers to the low resolution image. Applicant respectfully submits that this is not the appropriate interpretation that should be given and is inconsistent with the claim. In particular, as set forth in paragraph 1a, there is provided various aspects of an image, that is, the image is associated with:

- 1) a low resolution digital image file;
- 2) a high resolution digital image file; and
- 3) associated meta data

Thus, the image is generically referring to the image that is represented by the low and high resolution digital image file. It is the generic image that is being referred to. With regard to the ordering of goods or services, they generally deal with respect to the overall image, however, the high resolution digital image file is used for producing of the goods or services with respect to the generic image represented by the high resolution digital image file. Thus, the term “image” is not referring either to the low or high resolution digital image file, but the image represented by those files. Thus, with regard to the claims 1, 11, 21, 40 and 50 it is respectfully submitted that the terminology is appropriate.

With regard to claim 40, this claim has been amended to more precisely refer that the server is at a first location and the user computer is at a second location that is remote from the first location. The claim has also been amended to state that the user using the software on the server is with respect to the low resolution digital image file of the image at the first location, that is, using the software at the server provider and this is being used with respect to the low resolution digital image file.

Accordingly, it is respectfully submitted that claim 40 overcomes the objection set forth by the Examiner.

The Examiner has also objected that alternative language is inappropriate in that they are not equivalent. In this regard, Applicant respectfully

refers the Examiner to MPEP 2173.05(h) which discusses the use of alternative language. As stated therein, alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. The language used in the present application is not ambiguous or uncertain as to its meaning. As stated therein the digital image file is transmitted either upon completion of the manipulation or ordering of the goods or services or in situation wherein both are done when both are completed. These are not uncertain or ambiguous terms but defined when the images are being transmitted to the server. There is no requirement that the alternative language be equivalent. The test is whether there is presented uncertainty or ambiguity with respect to the scope or clarity of the claim. Applicant respectfully submits there is no such issue in the present claims.

In view of the foregoing, Applicant respectfully submits that the objections under 35 USC § 112 second paragraph are not applicable to the claims as currently set forth.

The Examiner also rejected claims 1-7, 11-17, 21-27 and 40-76 under 35 USC § 103(a) as being unpatentable over Hoekstra et al. for the reasons set forth therein.

As stated in MPEP 706.02(j):

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure ... The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’”

As Applicant has noted in the previous response, the present invention is directed to providing goods or services to a user wherein the high resolutions must be uploaded to the service provider. In order to make the

process more efficient, a low resolution image file is first uploaded to the service provider whereby user actions are allowed for manipulation and ordering of goods or services prior to receipt of the high resolution image. In addition, meta data is supplied with respect to the high resolution image that is at the user computer that can assist the service provider in providing feedback to the user with regard to the applicability of the image with regard to goods or services that have been ordered or with respect to manipulations that have been provided on the low resolution image.

This is in stark contrast to the goals and purposes of the '277 reference cited by the Examiner. In particular, the '277 reference is directed to a system where images that originate at a first location are to be modified according to instructions provided by the originator by an expert manipulation facility located at a second location. Nowhere does Hoekstra teach or suggest first transmitting the low resolution image file of an image to a remote location of a service provider and wherein software is provided for manipulation and ordering goods by a user with respect to the image represented by the low resolution digital image file. In Hoekstra there is no teaching or suggestion of this remote manipulation or ordering as taught and claimed by Applicant. Thus, for this one reason alone, Hoekstra fails to teach or suggest the claimed invention. Furthermore, the present invention requires the uploading of the high resolution image file after completion of the ordering or manipulation of the images. Clearly, there is not teaching or suggestion in Hoekstra of uploading the digital images. Quite the contrary, the Hoekstra reference fails to teach or suggest the present invention.

The Examiner makes the statement in the last official action, "Hoekstra does not teach that the meta data contains information about the high-resolution digital image file. However, the Examiner notes that this limitation is not functionally involved in the steps or elements of the recited method or system. Therefore this limitation is deemed to be nonfunctional descriptive material." Applicant strongly disagrees with this, in particular the meta data provides information with regard to the high resolution image file and allows and provides the service provider to provide feedback. Thus, this is clearly relevant to the present invention and cannot be ignored as suggested by the Examiner. The statement by the Examiner the differences between the content of Applicant's

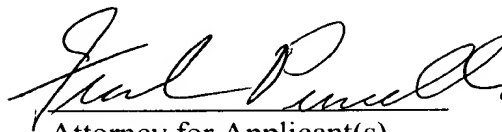
data and the prior art are merely subjective and thus nonfunctional descriptive material does not distinguish the invention from the prior art. In this regard, the meta data is not descriptive material suggested by the Examiner or of the type as set forth in *In re Dunlap*. The meta data provides specific information about the high resolution digital image file. This is information that can be used by the service provider in determining whether the desired manipulation and/or goods or services to be provided can be provided in an appropriate manner.

Further, Applicant would like to point out that functional limitations even at the point of novelty must be evaluated as with any other claim limitation (see MPEP 2173.05(g)). The Hoekstra reference fails to teach very specific elements of the claimed invention. The Examiner has attempted to say that these limitations are not relevant as they are functional or that it would have been obvious to one skilled in the art to place any information in the meta data. The information in meta data provided by Applicants provides an important aspect of the claimed invention as previously discussed. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the user edit the script file at the second location. However, this is contrary to what Hoekstra is directed to in that they are sending the image to the service provider for expert manipulation. It is not the user designed to make the manipulation nor is it designed for the user to remotely access and perform manipulation functions. Quite the contrary, all that is provided are instructions to the expert manipulator as to what is to be done. There is no teaching or suggestion that the user make any modification at the second location using software provided thereon. Applicant respectfully submits that the Examiner is using hindsight in an attempt to piecemeal reconstruct the present invention.

In view of the foregoing, Applicant respectfully submits that the claims, as currently set forth, are patentably distinct over the cited prior art and are in condition for allowance and such action is respectfully requested. With regard to claims 10, 20 and 30, these are dependent claims which depend upon the independent claims which are patentably distinct over the Hoekstra reference. The Hoekstra reference does not teach anything that would render the independent claims, upon which these claims depend, obvious.

In view of the foregoing, Applicant respectfully requests allowance of the subject application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank Pincelli", written over a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.